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| 09/378,159 | 08/19/1999 | DAVID L. PATTON | 79770F-P | 8786 |

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PATENT LEGAL STAFF
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EXAMINER

VIG, NARESH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3629

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

TR

Office Action Summary

Application No.

09/378,159

Applicant(s)

PATTON ET AL.

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 August 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 – 23, 26 – 27, 32 – 50 and 54 – 55 are rejected under 35 U.S.C. 102(e) as being unpatentable over Kara, U.S. Patent 5,819,240 hereinafter known as Kara1.

Regarding claims 1, 32, 42 and 49 – 50, Kara1 discloses “A system and method for printing a postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail”, and, “the user is also able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail.” User takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within

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the postage storage device. A desired amount of postage is entered into the storage device by a postal employee through a processor-based system. The desired amount of postage is printed as a meter stamp and may contain encrypted information for security purposes or may be customized as desired by the user. In addition, Kara1 discloses that the postage storage device can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of personalized postage indicia.

Regarding claims 2 and 3, Kara1 discloses a processor-based system where a user may invoke the system to access and retrieve a portion of the stored amount of postage via a program stored on a processor-based system, such program hereinafter referred to as the "E-STAMP" program. System is a general purpose computer, such as an IBM compatible (or Apple MacIntosh). System includes processor (CPU), disk drive, network interface card (NIC) coupled to computer network etc.

Regarding claims 4 – 6, Kara1 discloses that the user is able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can import personalized, or customized, postage indicia graphics into the interface program which allows a CPU to read a portable memory device, and to print this customized indicia on a piece of mail.

In addition Kara1 discloses information on how a user may change, add a new indicia, or otherwise select which indicia is desired for a given piece of mail.

Regarding claims 7 – 14, 38 and 45, 48, Kara1 discloses to provide a menu of postage indicia that can be selected by the customer for particular occasions. The user is able to create or select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can also personalize postage indicia. In addition, the user is provided with a message box to allow the user to add an optional message or greeting (e.g., "Happy Holidays") to be printed next to the meter stamp. This message may be changed at any time by the user, directly or by a "merge" command in conjunction with a word processing or graphics program coupled to the E-STAMP program. Although Kara1 does not disclose modifying the shape, size, color, or orientation of the said image, it is inherent when a user modifies an image, they modify the image to their desire and, within the guidelines of the servicing business (for example, within the guidelines of the post office).

Also, Kara1 does not disclose uploading custom image (to central authorizing computer), However, Kara1 does disclose the system and method for printing postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail. Therefore, it is inherent that Kara1 system and method is approved by the Postal Authority (for postal products) before it is made available for use to the general public.

Regarding claims 15 – 16, Kara1 discloses a portable postage storage device that can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of a personalized postage indicia. Under the control of a general purpose computer, it automatically calculates the amount of postage due for a particular piece of mail and imprinting that amount of postage in a personalized configuration of a meter stamp on an item of mail.

Regarding claims 17 – 23, 33 – 36, 38 – 41, 43 – 44 and 46, Kara1 discloses a system and method for printing a postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail. A user takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within the postage storage device, or, the user may also call a number (an authorized Post Office telephone number) and have the Post Office transfer the required amount of postage by modem. Also, Kara1 discloses a registration form which requires users to provide their name, address, phone mail etc.

Kara1 does not disclose electronic order form. Kara2 discloses that the POSTAGEMAKER program operates to allow the authorized refilling of the portable postage device remotely, such as, for example, through a public switched network (PSN) or LAN. (For example, the program may initiate communications with the

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POSTAGEMAKER program through the use of modems and telecommunications lines, upon establishing communications, the program may request an amount of postage to be replenished and indicate payment by such means as a valid bank card or a debit account maintained with the postal authority.) It is obvious at the time of applicant's invention to a person with ordinary skill in the art to include remote refilling to avoid user taking the device physically to the post office to replenish.

Also Kara1 does not disclose providing a receipt. Kara1 does disclose that, the amount and a conglomeration of encrypted data known as a security packet are sent to be decoded and validated, and, if all appears to be valid, perform the credit operation. If the response is acceptable, a receipt is printed out for the user and the results are written in a transaction log. Kara1 does not disclose receipt to include facsimile of the image to be used on the custom postage. It is inherent that the receipt can be in the form of facsimile, email, printed on user's system printer, mail etc. It is known at the time of applicant's invention to a person with ordinary skill in the art to provide/print a receipt for the user to make replenishment of postal storage device a legal transaction and also to avoid user disputes.

Regarding claims 26 and 27, Kara1 discloses system and method, under the control of a general purpose computer, for automatically calculating the amount of postage due for a particular piece of mail and imprinting that amount of postage in a

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personalized configuration of a meter stamp on an item of mail (a postcard, an envelope, a letter or a label through a printer).

Regarding claims 37 and 47, Kara1 discloses that when the user clicks on the desired indicia and then has the option of personalizing the indicia. The indicia may be personalized with information such as the name of the person, birthday that person is celebrating etc. Once an insignia has been created that the user likes, the selected indicia (with personalization) will be printed as part of the postage meter stamp on a piece of mail. The user may then choose to add the personalized selected indicia to the program or to delete it

Regarding claims 54 and 55, Kara1 discloses "A system and method for printing a postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail", and, "the user is also able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail." A user takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within the postage storage device. A desired amount of postage is entered into the storage device by a postal employee through a processor-based system. The desired amount of postage is printed as a meter stamp and may contain encrypted information for security

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purposes or may be customized as desired by the user. In addition, Kara1 discloses that the postage storage device can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of a personalized postage indicia.

Also, Kara1 discloses that the user is able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail. User can import personalized, or customized, postage indicia graphics into the interface program which allows a CPU to read a portable memory device, and to print this customized indicia on a piece of mail.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 – 24, 28 – 31 and 51 – 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara U. S. Patent 5,819,240 hereinafter known as Kara1 in view of Kara U. S. Patent 5,717,597 hereinafter known as Kara2.

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Regarding claims 24 and 25, neither Kara1 nor Kara2 disclose notifying whether the submitted custom postage has been authorized. However, Kara1 discloses that users can select type of indicia from the menu for customization. It is notoriously well known that an authorizing authority informs the applicant about their decision on the applicant's application and/or petition. Thus, it would have been obvious to modify Kara1 and Kara2 to include notification to the user informing them about the status of their custom postage approval application to minimize the application status inquiry from their applicants.

Regarding claim 28 – 31 and 51, kara2 discloses that the user may change the indicia, add a new indicia, or otherwise select which indicia is desired for a given piece of mail. The user has the option of personalizing the indicia. Once an insignia has been created that the user likes, the selected indicia will be printed as part of the postage meter stamp on a piece of mail. Kara1 does not disclose to have limit for manipulating the image. However, it is notoriously known that that authorizing authority allows design changes within the guidelines of the agency. Thus, it would have been obvious to modify Kara1 and Kara2 to include the limit for manipulating the image to meet the guidelines of the authorizing postal authority.

Claims 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara U.S. Patent 5,819,240 in view of D'Entremont et al. U.S. Patent 5,886,334.

Regarding claims 52 - 53, Kara1 discloses "A system and method for printing a postage meter stamp, including a desired postage amount and a personalized postage indicia, onto a piece of mail", and, "the user is also able to create or to select one of a variety of graphical configurations of postage indicia to be imprinted as the postage meter stamp on a piece of mail." A user takes a postal storage device to the Post Office in order to obtain a replenishment of the amount of postage stored within the postage storage device. A desired amount of postage is entered into the storage device by a postal employee through a processor-based system. The desired amount of postage is printed as a meter stamp and may contain encrypted information for security purposes or may be customized as desired by the user. In addition, Kara1 discloses that the postage storage device can be coupled to processor-based systems to receive and retrieve an amount of authorized postage and the printing of a personalized postage indicia.

Kara1 does not disclose providing a receipt. Kara1 discloses that the amount and a conglomeration of encrypted data known as a security packet are sent to be decoded and validated, and, if all appears to be valid, perform the credit operation. If the response is acceptable, a receipt is printed out for the user and the results are written in a transaction log. Also, Kara1 does not disclose receipt to include facsimile of the image to be used on the custom postage. It is notoriously known to a person with ordinary skill

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in the art that the receipt can be in the form of facsimile, email, printed on user's system printer, mail etc. It is known at the time of applicant's invention to a person with ordinary skill in the art to print receipt for the user to make replenishment of postal storage device a legal transaction and also to avoid user disputes.

Additionally, Kara1 does not disclose a barcode reader. D'Entremont et al. discloses an apparatus and methods for recording data onto a document for recording text, image and graphic data onto a document and for automatically inspecting the recorded data. D'Entremont apparatus includes a central processing unit, a barcode reader etc. Also, it is notoriously known to a person with ordinary skill in the art that a barcode reader is an input device. The barcode reader captures the barcode information from a barcoded label and converts the optically encoded information to serial data before they are transmitted to the computer. It would have been obvious to a person with ordinary skill in the art to modify Kara1 and add a barcode reader to the computer to meet additional requirements of the Postal Service (should the post office decides to use barcode identification for correspondence).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. Kara, U. S. Patent 5,819,240 discloses System And Method For Generating Personalized Postage Indica.

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2. Kara, U. S. Patent 5,717, 597 discloses System And Method For Printing Personalized Postage Indicia On Greeting Cards.
3. D'Entremont et al. U. S. Patent 5,886,334 discloses Systems And Methods For Recording Data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is 703.305.3372. The examiner can normally be reached on M-F 7:30 - 5:00 (Alt Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.746.7239 for regular communications and 703.746.7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.305.3900.

May 16, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
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